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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,549	05/24/1999	EMMANUEL GERLOVIN	PAS-093	7946

959                  7590                  11/29/2002

LAHIVE & COCKFIELD  
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BOSTON, MA 02109

[REDACTED] EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
2123	

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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## **DETAILED ACTION**

### **Introduction**

1. **Claims 1-33 of U. S. Application 09/316,549 filed on 24-May, 1999, are presented for examination.** Applicants were asked to supply documents *material to the patentability of the claims* (paper # 3, paragraphs 7-9). Applicants respond (paper # 6) that providing the software packages is “based on the incorrect belief that Applicant attempted to incorporate Pro/Engineer by Reference”. This is an inaccurate statement relating to the request for information (see paragraphs 7-9, paper # 3). Therefore, please note the following Requirement for Information under 37 C.F.R. 1.105.

### **Requirement for Information - 37 C.F.R. § 1.105**

2. **Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:**

- Pro/Engineer 2000i: The Examiner requires user's manuals for “Pro/ENGINEER 2000i” which Applicants refer to in the specification (lines 11-13):

“The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a feature-based model.”

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- Pro/Engineer: The Examiner also requires user's manuals for "Pro/ENGINEER" which has been developed by the current assignee and which appears to disclose the claimed invention (Applicants refer to Pro/Engineer in the IDS - paper # 5). The Examiner notes that Parametric Technology Corporation is the assignee for the instant application.

- Pro/Intralink: The Examiner also requires user's manuals for "*Pro/Intralink*", which has been developed by the current assignee and which appears to disclose the claimed invention. The Examiner notes that Parametric Technology Corporation is the assignee for the instant application.

**3. The information is required to enter in the record the art suggested by the applicant as relevant to this examination in the specification (lines 11-13, page 4):**

- user's manuals for Pro/Engineer 2000i (as well as earlier versions): Applicants refer to "Pro/ENGINEER 2000i" in the specification (lines 11-13):

"The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a feature-based model."

**4. In response to this requirement, please provide a complete copy of each of the following items of art referred to in the specification (lines 11-13, page 4) and the Information Disclosure Statement (paper # 5):**

- user's manuals for Pro/Engineer 2000i (as well as earlier versions): Applicants refer to "Pro/ENGINEER 2000i" in the specification (lines 11-13):

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**"The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a feature-based model."**

- Pro/Engineer; see item "A6", paper # 5 (IDS).

5. For the reasons provided, the commercially available *user's manuals* for "*Pro/Engineer*" and "*Pro/Intralink*" are considered especially relevant to the instant application and should be submitted to the Examiner for consideration. The text accompanying the Pro/Engineer 2000i reference provides a short description which indicates that the listed reference, is considered very relevant and appears to be *essential* to the instant invention and claims, and therefore the applicant is required to provide the office with copies of the references for consideration. The Examiner requires the user's manuals, which have already been made available to the public, because the Examiner needs to consider them in so far as they *appear to be material to the patentability of the application as per 37 C.F.R. 1.56*. It is also noted that Applicants have *already* provided three pages from the Pro/Engineer Part Modeling User's Guide from Parametric Technology Corporation. The Examiner requires the *entire* document.

6. **The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement.** This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information

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disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

**7. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.** Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item. Applicants are reminded that they have referred to the material in the specification and have relied upon the material in a declaration in order to attempt to traverse 112(1) rejections.

**8. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

**9. Any inquiry concerning this communication or earlier communications from the examiner should be:**

**directed to:** Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:** Commissioner of Patents and Trademarks

Washington, D.C. 20231

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**or faxed to:** (703) 308-9051 (for formal communications intended for entry) *or*  
(703) 308-1396 (for informal or draft communications, please label “*PROPOSED*”  
or “*DRAFT*”).

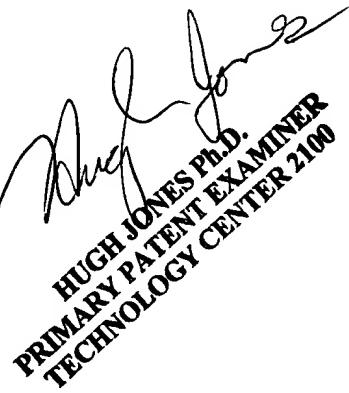
Dr. Hugh Jones

Primary Patent Examiner

November 26, 2002



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